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R E M A R K S

1. Status of claims:

Claims 11, 14, 17, 18 and 77 have been canceled. Claims 1-10, 12, 13, 15 and 16 are pending.

2. Request for withdrawal of Finality as premature:

Applicant respectfully requests that if this application is not allowed, the finality of the current Office Action be withdrawn as premature because the grounds of rejection are new and were not caused by amendments made by the applicant.

In particular, claims 1, 3-5 and 11-13 as now presented are in the same form as originally issued in the patent. These claims have not previously been rejected on the basis, as now included in the Final Office Action for the first time, that:

(A) the teachings in Freeny of means for associating and embedding an identification code, such as "owner codes, catalog reproduce code or catalog transmit code" are said to anticipate the claim language which specifies means for associating and embedding an identification code with or on a software carrier wherein "said identification code comprising at least one of the following identification parameters: purchaser identification, point of sale identification and date of purchase", or that

(B) it would have been obvious to modify Freeny to include purchaser information, such as credit card authorization information, into control unit 34, because the language in the claim of "said identification code comprising at least one of the following identification parameters: purchaser identification, point of sale identification and date of purchase" is said to be non functional descriptive material.

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If the finality of this rejection is not withdrawn, Applicants will not have had the opportunity to counter these rejections as a matter of right.

3. Request for entry of amendment under 35 CFR 1.116:

In the alternative, Applicants respectfully request that this amendment be entered under 37 CFR 1.116(b) 1 and 3 for the following reasons:

- (1) rejected claims 11, 14, 17, 18 and 77 are canceled;
- (3) this amendment is necessary because the rejections presented in the Final Action are new and Applicants have not yet had the opportunity to counter these rejections.

4. Summary of Applicants' response to the anticipation rejection

Claims 1-10, 12, 13, 15 and 16 stand rejected under 35 U.S.C. 102(e) as anticipated by Freeny. Claim 77 has been canceled.

Applicants traverse this rejection as not being a prima facie 102(e) rejection in that Freeny does not teach the claimed elements. In particular, claim 1 as originally issued and as now presented calls for

"said identification code comprising at least one of the following identification parameters: purchaser identification, point of sale identification and date of purchase, wherein said means for associating comprises means for embedding said identification code on the software carrier wherein said means for associating further comprises means for embedding said identification code on the software carrier".

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The Examiner, at the top of page 3 of the rejection, has said that Freeny teaches embedding an identification code indicating "owner codes, catalog reproduce codes or catalog transmit codes". As noted in a previous response, the owner is the seller or someone represented by the seller rather than a purchaser.

The embedding specifically of purchaser identification, point of sale identification or date of purchase cannot be anticipated by Freeny which does not teach the embedding of such identification codes.

5. The Examiner's interpretation under 35 U.S.C. 112, 6th

The Examiner may be relying, for the above described anticipation rejection, on his interpretation noted in par. 7 of the Office Action regarding 35 U.S.C. 112, 6th to eliminate the claim language limitation, in claim 1, that "said identification code comprising at least one of the following identification parameters: purchaser identification, point of sale identification and date of purchase." However, whether or not the "means for associating ..." invokes §112 6th, the claim language cited above specifying that the identification code comprises at least one of the specified elements remains a claim limitation, for example, with regard to the "means for embedding said identification code on the software carrier."

Applicants traverse the Examiner's interpretation under §112 6th.

Applicant respectfully reminds the Examiner that the Examiner has stated in a previous office action that his interpretation of the last two claim elements was believed by the Examiner to be a matter of first impression.

As noted in Applicant's prior response, and not refuted by the Examiner, the Federal Circuit has interpreted "nested" means-plus-function clauses without collapsing them into a single element having the same structure: see, for example, Lockheed Martin Corp.

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v. Space Systems/Loral Inc., 66 U.S.P.Q. 2d 1282 (Fed. Cir. 2003 and Versa Corp. v. Ag-Bag International Ltd., 73 U.S.P.Q. 2d 1191 (Fed. Cir. 2004. The Examiner's position is therefore directly at odds with Federal Circuit precedent.

The rejection also fails to provide a prima facie anticipation of the invention as claimed in that several of the elements said to be disclosed in Freeny are not disclosed therein.

In particular, in par. 4, Freeny is said to disclose memory within digital storage unit 86 in POS 14 which anticipates the claim element "a memory for storing software for distribution to customers" as claimed in claim 1. Applicant respectfully traverses. In particular, the memory in digital storage unit 86 stores encoded information which must be decoded to create the information distributed to customers.

Freeny is also said to disclose means for embedding an identification code in the software within reproduction unit 24 which anticipates the claim element "means for embedding said identification code on the software carrier" as claimed in claim 1.

Applicants traverse and request, if this rejection is maintained, that the Examiner cite a location in Freeny which discloses that the reproduction unit embeds an identification code on the software carrier provided to the customer.

Freeny is also said to disclose means for preventing copying which anticipates the claim element "means for preventing copying of software copied onto the software carrier" as claimed in claim 4. Applicants traverse and respectfully point out that to the extent that Freeny can be said to teach the use of "owner codes, decipher program, etc.", Freeny teaches such use for the prevention of copying information onto the software carrier without proper accounting to the owner rather than teaching means for preventing copying of software already on the software carrier.

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6. Applicants' response to the obviousness rejection:

Claims 1-10, 12, 13, 15 and 16 stand rejected under 35 U.S.C. 103(a), as obvious over by Freeny. Claim 77 has been canceled.

The Examiner has rejected these claims stating that it would have been obvious to modify Freeny to input purchaser identification, such as credit authorization, into manufacturing control unit 34 because Freeny allows the inputting of "other various data" into control unit 34 based on his position.

Applicants traverse this rejection as not being a prima facie §103(a) rejection because data written to control unit 34 in Freeny is not applied to the software carrier as required by the claim language. In particular, control unit 34 does not reproduce the received information in a material object (such as a software carrier). Control unit 34 provides the authorization select code on line 50 to manufacturing unit 36 which permits unit 36 to decode the encoded information provided thereto by file unit 32 on line 48. It is this information which is provided on line 22 to reproduction unit 24 for application to the software carrier, see Fig. 1 and col. 10, line 5 through col. 11, line 2.

If this rejection is maintained, Applicants respectfully request that the Examiner indicate where Freeny teaches or suggests that the "various other data" that may be applied to unit 34 would be applied to the software carrier.

Further, the section of Freeny cited by the Examiner teaches that such "various other data could be inputted into manufacturing unit 34 ... for inventory of materials control or other general accounting data, if desired." The use of such data for inventory control or accounting teaches away from the use of such data for application to the software carrier to be distributed to a customer. That is, inventory control and accounting are functions performed at the seller's location or on the seller's behalf. Embedding

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information on the software carrier distributed to customers is not consistent with inventory control or accounting by the seller disclosed in Freeny.

The Examiner stated that he considers the claim language "said identification code comprising at least one of the following identification parameters: purchaser identification, point of sale identification and date of purchase" to be non functional descriptive language and therefore not capable of distinguishing the claim over the prior art. Applicants respectively traverse. The embedding of purchaser information, point of sale and/or date of purchase information is functional. For example, such embedding may be used to reduce or prevent copying because the original purchaser can then be identified from each copy of software used. That is, a copy of software used by person A can quickly and easily be evaluated to determine if that software was legally purchased by person A or by another person or not at all.

7. Rejections of claims 11, 14, 17 and 18.

Claims 11, 14, 17 and 18 stand variously rejected. In order to expedite the allowance of this application, claims 11, 14, 17 and 18 have been canceled.

8. Rejection of claim 77.

Claim 77 stands rejected as based on a defective reissue oath. The Examiner has stated that a supplemental reissue oath must be received before this reissue application can be allowed. In order to expedite the allowance of this application, claim 77 has been canceled.

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Applicants respectfully requests that the rejections herein be reconsidered in light of the amendments and arguments presented and the application be passed to issue.

If the application is not passed to issue, Applicants request that the finality of the rejections be withdrawn to permit the Applicants to make the above arguments to the new grounds for rejection presented for the first time in the current rejection by the Examiner against claims as originally issued in the parent case.

If the finality of the rejections are not withdrawn, Applicants request that the amendments made herein be entered to reduce the issues necessary for discussion before the Pre-Appeal Brief Conference and/or on Appeal.

Respectfully Submitted,

Date: 9/6/2006

/Norman E. Brunell Reg. No. 26533/
Norman E. Brunell Reg. No. 26,533

Irell & Manella LLP
Customer No. 29000
1800 Avenue of the Stars, Suite 900
Los Angeles, CA 90089-4276
(310) 277-1010
(310) 203-7199 Facsimile
nbrunell@irell.com